

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number  
**1064 001 301 0202**Application Number  
**09/919,275** Filed  
**July 31, 2001**First Named Inventor  
**Arthur Papier**Art Unit  
**3685** Examiner  
**J. Winter**Confirmation Number  
**4087**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature /Duane C. Basch, Esq., Reg. No. 34,545/

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

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Registration number if acting under 37 CFR 1.34

Date Dec. 23, 2010

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

\* Total of 1 forms are submitted.

**35 U.S.C. §101**

**Claims 3, 4, and 31-36** remain rejected under 35 U.S.C. §101. Claim 3 was previously amended to overcome the rejection under §101 (see Amendment/Response filed Mar. 18, 2010). The Final Office Action dated June 24, 2010 (hereinafter “June 24<sup>th</sup> Action”) contains no discussion or acknowledgement that the amendment was considered (the rejection at pp. 4 – 5 of the June 24<sup>th</sup> Action is a verbatim copy of the earlier rejection). Nor does the June 24<sup>th</sup> Action address Appellant’s arguments in traversal of the rejection.

Appellants’ respectfully incorporate herein the arguments set forth at p. 9 of the Response filed March 18, 2010 as summarized below. Specifically, independent claim 3 positively sets forth the machine (computer, and mass storage device operatively associated with the computer) upon which the database resides, along with the diagnostic engine for generating possible diagnoses as set forth in claim 3. In view of the amendments to claim 3, Appellants submit that claims 3 and 4 are tied to a statutory class and meet the requirements of 35 U.S.C. §101 and are not mere post solution activity. Furthermore, claim 3 recites the change in images presented on the user interface, clearly setting forth subject matter that is being transformed.

With respect to claims 31-36, no basis for the rejection has been properly set forth, thus there is no *prima facie* showing to which Appellants can or must respond. Rather, the “rejection” of claims 31-36 relies solely upon the incorrect statement that the claims “contain similar limitations.” (June 24<sup>th</sup> Action, p. 5) Appellants note that claim 31 includes positive recitations of a computer, an image database and knowledge database both accessible by the computer, a user-interface, and a diagnostic engine operated by the computer. Having positively recited various aspects of the computer that accomplish the method steps, Appellants respectfully urge that claim 31 meets the requirements under §101 and remains improperly rejected, or at best the incomplete rejection precludes a further response.

**35 U.S.C. §103(a)**

**Claims 1-15, 19, 22-24, 31-32 and 35-36** were rejected under 35 U.S.C. §103(a) as being unpatentable over Wilk in view of Bodick. In the Examiner’s “Response to Arguments (June 24<sup>th</sup> Action, p. 2) Appellants respectfully submit that the Examiner failed to review the prior reply and has mischaracterized Appellants arguments.

Appellants respectfully contend that the inherent ambiguity of medical diagnosis requires, not automated diagnosis as taught by Wilk and Bodick, but a system and method for knowledge presentation that facilitates rapid comparison and perception by the user - an essential distinction set forth in the rejected claims. For example, the presentation of a plurality of images (e.g., claim 1) in the claimed diagnostic stack (e.g., claim 6), constitute patentably distinguishable aspects the invention. .

Wilk and Bodick are not properly combined to establish *prima facie* obviousness. As previously noted, the two patents teach away from one another and fail to support the combination/modification urged as the basis for the rejection. Wilk is clearly directed to a medical diagnostic system described as having a device 20 for monitoring and measuring a biological or physiological parameter, transmitting the parameters to a computer 24, and ultimately communicating a medical diagnosis as determined by the computer. As set forth at col. 3, lines 58 – 63 of Wilk, “[b]ecause diagnoses are made by computer in accordance with the present invention, it is frequently unnecessary to have a doctor present during data taking (symptom recording and measurement) and communication of the diagnosis to the patient.” (underlining added).

Bodick, directed to the creation and editing of a knowledge base for use as an aid to the cognitive process of diagnosis, discloses the creation of a knowledge base containing both pictorial images and textual information therein (col. 2, lines 39-40), along with a system to use such information in a medical diagnosis. Appellants continue to urge that when taken in context, Wilk does not suggest the use or display of an image as described by Bodick (at best the cited language indicates a reduction in the time for examination, not necessarily diagnosis) – one of ordinary skill in the art would not be so motivated as the “Computer 24 is operated ... to derive a diagnosis...” (Wilk; col. 4, lines 65-69). It also remains unclear what would have motivated one skilled in the art to modify Wilk’s automated medical diagnostic system to make it “unautomated” and used for searching of case data as required by Bodick. Appellants continue to urge that the proposed modification of Wilk in view of Bodick is improper in view of the teaching away by Wilk. The proposed combination is contrary to the teachings.

While Wilk does disclose the storage of images, it does not disclose the storage of images in an image database, nor the cross-referencing of the image database with a knowledgebase for purposes of assisting in the diagnostic process as recited in the rejected independent claims (e.g., claims 1, 3, 5 and 31). Appellants’ review of Wilk did not identify reference to a database, let alone separate image and knowledge databases. Rather, what was found was reference to bulk storage and memory (e.g., 28 in Fig. 1), which clearly do not teach the separately recited image database and knowledge database as set forth in the rejected claims. No support has been set forth to establish that one of skill in the art would have identified a knowledge database in Wilk, let alone a knowledge database separate from the image database. There simply is no teaching or suggestion of the recited limitation, particularly where the knowledge database is cross-referenced to the image database (e.g., claim 1), nor does the rejection demonstrate how or why one of skill in the art would have arrived at the understanding alleged in support of the rejection. Thus, *prima facie* obviousness cannot be established based upon Wilk’s alleged teachings.

As previously conceded, Wilk fails to disclose identifying a subset of diagnoses and using the subset of diagnoses to reorganize an information space of the image database for concurrent presentation of a plurality of images for user review via the user-interface as set forth in the independent claims. Nonetheless, to make up for the acknowledged gap in Wilk's teachings, the rejection relies upon Bodick and urges that Bodick teaches the limitations of the independent claims not taught by Wilk. Bodick discloses the creation of a knowledgebase containing both pictorial images and textual information therein (col. 2, lines 39-40). The system is further described as being dynamic; to permit the addition of newly discovered characteristics observed in patients and deletion of characteristics having little diagnostic importance. As Bodick points out, the disclosed knowledgebase is distinct from a classic database (col. 3, lines 12-16). Although Bodick does describe alternative methods of accessing the knowledgebase Appellants respectfully maintain that such a teaching does not give rise to the recited limitations of "automatically identify[ing], from a plurality of possible diagnoses, a subset including a plurality of diagnoses that are consistent with the characteristics." Accordingly, particularly with regard to the claimed limitation of "automatically reorganizing an information space of said image database for concurrent presentation of a plurality of images for user review," Appellants respectfully submit that no such teaching is found in Bodick, and that Bodick, in fact, teaches away from such a limitation. For example, at col. 2, lines 59-61, where a comparison is described between "one patient or sample" and a "previous patient or sample" there is nothing to suggest that more than a single representation is displayed at one time – resulting in a user having to remember a prior image(s). Similarly, col. 6, lines 19-22 of Bodick clearly indicate that information from a single record is displayed – not the concurrent presentation of a plurality of images for user review, reflecting a subset of diagnoses, as recited in the rejected claims (e.g., claim 1).

Even considering, *in arguendo*, a combination of Wilk in view of Bodick, at most the combination teaches the use of a common collection of data or knowledge for an automated medical diagnostic system. The modifications "suggested" by Bodick (with arguments to the contrary presented previously) would, at most, result in a system where the data of the Wilk may be searched and text and/or an image from a case displayed to a user of the system as suggested by Bodick. Such a combination or modification does not, however, teach the automated identification of a subset having a plurality of diagnoses, in response to characteristics, let alone using the subset of diagnoses, automatically reorganizing an information space of the image database for concurrent presentation of a plurality of images for user review as set forth in the independent claims.<sup>1</sup> The claims are, therefore, patentably distinguishable over the arguable combination.

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<sup>1</sup> See e.g., pages 25 – 28 of the Specification, and Figures 12 and 14.

The June 24<sup>th</sup> Action (p. 4) urges that Bodick's teaching of side by side presentation of image and text information teaches concurrent display of a plurality of images. Once again, Appellants refute this allegation. Moreover, it does not appear, from the numerous display examples shown in Bodick, that there is a display depicting a plurality of images. Bodick teaches, relative to Figs. 13A, 14 and 14A, "[t]he flow chart of FIG. 14A, which is reached from the flow chart of FIG. 13A, depicts how this viewing of an image is carried out, and FIG. 14 illustrates a display screen of what is viewed by the expert" (col. 23, lines 65-68; emphasis added). Thus, in spite of the Examiner's urging to the contrary, Bodick teaches a single image display and fails to teach or suggest the concurrent presentation of a plurality of images associated with a subset of diagnoses for user review as recited in the rejected claims. Accordingly, Appellants' respectfully request that the Conferencees overturn the rejection of claims 1, 3, 5 and 31, as well as claims dependent therefrom.

With regard to dependent claims 2 and 4, the claims recite automatically reorganizing the information space in response to a user's modification of a descriptive characteristic. Contrary to the Examiner's reference to cols. 2, 5 and 30 of Bodick, no such teaching has been identified or illustrated.

Considering the rejection of claims 6 – 11 and 31, the Examiner acknowledges that Wilk [sic] fails to teach an image stack, yet maintains that Bodick discloses a diagnostic image stack by disclosure of a diagnostic tree in Figure 26. Appellants continue to urge that Bodick is clear as to the contents of Figure 26; at col. 9, line 22, Figure 26 is described as "a display used in selecting a diagnosis tree." Appellants remain uncertain as to what information the Examiner asserts to support the presence of a "diagnostic image" let alone the recited "diagnostic image stack" as set forth in rejected claim 6, for example. Appellants respectfully maintain that the hierarchy depicted in Bodick does not teach a plurality of images or a diagnostic image stack as the term has been employed in the instant application, as a group of images in the context of diagnostic possibilities. Accordingly, Appellants maintain that *prima facie* obviousness has not been established relative to claims reciting the diagnostic image stack, and particularly claims 6 – 11.

Appellants further note that the Office Action continues the failure to specifically address Appellants' prior arguments set forth relative to claim 8, where *prima facie* obviousness has not been established relative to claim 8.

With respect to claims 19 and 22-23, the Examiner again acknowledged that Wilk and Bodick both fail to teach the alternative applications (oral medications, autopsy, crime scene) set forth in claims 19 and 22-23. Nonetheless, the rejection continues to be maintained. Appellants continue to respectfully maintain that *prima facie* obviousness has not been established. The conferees are respectfully requested to overturn the rejection as to claims 19 and 22-23, there being no basis to support the rejection.

Appellants continue to note that while claim 32 was included in the rejection, the Office Action does not specifically include a rejection for claim 32. Thus, Appellants respectfully request withdrawal of the rejection as applied to claim 32.

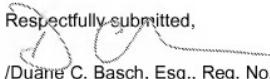
With respect to the remaining rejected dependent claims Appellants reserve the right to separately address the patentability of such claims in the Appeal Brief.

**Claims 16-18, 20-21 and 33-34** were rejected under 35 U.S.C. §103(a) as unpatentable over Wilk in view of Bodick and now “Official Notice.” With regard to the rejection, Appellants previously questioned the Examiner’s “Official Notice” as to the use of icons as specifically set forth in the claims. The rejection states that “Official Notice” is taken as to the missing element of Wilk and Bodick. The Examiner has indicated at p. 12 of the June 24<sup>th</sup> Action that Wilk and Bodick “fail to disclose wherein the user interface to solicit a plurality of characteristics includes at least one symptom represented as an icon,” for example, as set forth in claim 16. In the next sentence, the Examiner takes official notice that “it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to use icons as a matter of convenience for the user.” Notably, the rejection does not take official notice of the use of icons to depict symptoms as is claimed (e.g., claim 16). Nor does the Moukhelir patent teach or suggest the use of icons in such a manner. Absent some teaching or suggestion of the recited limitations, Appellants respectfully submit the reliance upon Moukhelir is an incomplete attempt at a hindsight reconstruction of the recited claim elements using the claims as the “recipe.” Accordingly, *prima facie* obviousness is not established and the conferees are respectfully urged to withdraw the rejection.

Appellants further urge that even if considered, *in arguendo*, the addition of Moukhelir or other “Official Notice” as to the allegedly known use of icons does not give rise to the use of icons in the manner(s) specifically recited in the rejected claims. Accordingly, Appellants respectfully traverse the rejection, request that the rejection be overturned by the Examiner, and that claims 16-18, 20-21 and 33-34 be indicated as allowable.

#### CONCLUSION

The rejection under 35 USC §101 is overcome by prior amendment of claim 3 and was improperly applied relative to claims 31-36. Claims 1 - 15, 19, 22 – 24, 31-32 and 35-36 were improperly rejected under 35 USC §103(a) as being unpatentable relying on Wilk in view of Bodick. In the alternative, when considered *in arguendo* the rejection omits elements recited in the rejected claims. Claims 16-18, 20-21 and 33-34 were also improperly rejected under 35 USC §103(a) as being unpatentable over Wilk in view of Bodick and further in view of “Official Notice,” because the rejection fails to set forth the enumerated limitations relative to icons. Withdrawal of all rejections is respectfully requested.

Respectfully submitted,  
  
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